



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,413	07/06/2000	R. Douglas Hudgens	8017-244	6315

7590 07/05/2002

James B Myers Esquire  
Woodard Emhardt Naughton Moriarty & McNett  
Bank One Center Tower  
111 Monument Circle Suite 3700  
Indianapolis, IN 46204-5137

EXAMINER

HAMLIN, DERRICK G

ART UNIT	PAPER NUMBER
----------	--------------

1751

DATE MAILED: 07/05/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=4

**Office Action Summary**

Application No.

09/611,413

Applicant(s)

HUDGENS, R. DOUGLAS

Examiner

Derrick G. Hamlin

Art Unit

1751

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Double Patenting***

Claims 1-22 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-24 of copending Application No. 09/611,332. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a corrosion inhibitor formulations, for use in a glycol based coolant containing phosphate or borate, molybdates, nitrites, nitrates, azoles (e.g. mercaptobenzothiazole or tolyltriazole), silicates and saturated aliphatic dicarboxylic acids having between 9 and 12 carbon atoms (e.g. adipic acid or sebacic acid) or their salts.

---

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1751

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Evaluations of level of ordinary skill in the art requires consideration of factors such as various prior art approaches employed, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, failure of others, and the inventor's educational level.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Little (US 5,071,580 A).

Little discloses a corrosion inhibitor slurry is disclosed which is suitable for addition to a selected liquid coolant capable of dispersing at least one glycol having from 3 to 5 carbon atoms per molecule. The slurry consists of a mixture of (a) a treatment composition comprising corrosion inhibitor, capable of dispersing in said selected liquid coolant and consisting of solid and, optionally non-solid components; and (b) a liquid vehicle selected from glycols which have 3 to 5 carbon atoms per molecule and disperse in said selected liquid coolant. (abstract) The treatment compositions employed in this invention consist of solid and, optionally, non-solid components, which are capable of dispersing in the selected coolant (s). Typically, the treatment composition itself will be completely solid such as the compositions heretofore used in

---

producing powders and briquettes conventionally employed in charging filters for heavy-duty truck coolant systems. Treatments containing phosphate-based corrosion inhibitor formulations and borate -based corrosion inhibitor formulations are thus preferred. These corrosion inhibitor formulations generally contain other corrosion inhibiting components in addition to phosphate and/or borate. For example, the phosphate -based inhibitors may comprise, in addition to phosphate (e.g. dipotassium or disodium phosphate), one or more additional conventional corrosion inhibitors such as molybdates, nitrites, nitrates, azoles (e.g. mercaptobenzothiazole or tolyltriazole), silicates (e.g. sodium metasilicate), and saturated aliphatic dicarboxylic acids having between 4 and 12 carbon atoms (e.g. adipic acid or sebacic acid) or their salts. Borate -based corrosion inhibitor formulations may comprise, in addition to borate (e.g. sodium tetraborate), the same additional corrosion inhibitors. Of course, both phosphate and borate may be used within these formulations (as pH stabilizers or buffers). (col. 3, lines 40-64) Example I (col. 6, lines 18-45) discloses a solid premix treatment composition comprising a conventional-type phosphate-based corrosion inhibitor formulation was

---

prepared by mixing thirteen solid ingredients in a powder mixer in the following proportions:

Dipotassium phosphate, anhydrous 34.00 parts  
Potassium nitrate 18.00 parts  
Sodium molybdate dihydrate 8.10 parts  
Sodium nitrite 6.75 parts  
Disodium adipate 5.40 parts  
Mercaptobenzothiazole (obtained as 5.40 parts unoled reagent from Uniroyal) Sodium metasilicate pentahydrate 4.50 parts  
Tolyltriazole (obtained 100% active 3.60 parts as Cobratec TT-100 from PMC Specialties Group, Inc.)  
Sodium xylene sulfonate (powder) 2.70 parts

Application/Control Number: 09/611,413

Art Unit: 1751

Polyacrylate (obtained 100% 0.54 parts active as Goodrite K-739 from B. F. Goodrich)  
Acrylate-sulfonated acrylamide copolymer 0.54 parts (obtained 90% active as Endcor  
4623 from W. R. Grace & Co.)  
Silicone surfactant (obtained 100% 0.36 parts active as Dow Corning 544 from Dow  
Chemicals)  
Polyethyleneoxide (obtained 100% 0.11 parts active as Polyox WSR-301 from Union  
Carbide)  
TOTAL 90.00 parts.

The claims are anticipatory or in the alternative they would have been obvious in view as the reference teaches all of the instantly claim components I the instantly claimed amounts. Additionally, they teach the use of all of the required components in the correct amounts in one inventive example, however the reference fails to teach the pH for the composition. It is the examiners position that the materials are identical and would therefore inherently have the same properties.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wilson et al. (US 4,548,787) and Parbon Jr., Et al. (5,997,763) also teaches all of the required components. Uekusa et al. (US 5,378,360) discloses all of the required components, however it teaches away from the use of silicates.

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (703)

Application/Control Number: 09/611,413  
Art Unit: 1751


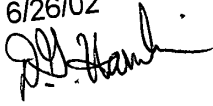
305-0590. The examiner can normally be reached on Monday-Thursday and alternating Fridays from 7:30 AM - 4:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 305-3600.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Derrick G. Hamlin

6/26/02



YOGENDRA K. GUPTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700